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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,293	03/20/2001	David G. Abdallah JR.	FIRE.P9905052	2286

7590

05/20/2003

John H. Hornickel  
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EXAMINER

JOHNSTONE, ADRIENNE C //

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,293

Applicant(s)

ABDALLAH, DAVID G.

Examiner

Adrienne C. Johnstone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-18, 21-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10, 21-26, and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2003 has been entered.

### *Election/Restrictions*

2. Claims 11-18 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6 (see Paper Number 7 paragraph 1).

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

To provide proper antecedent basis applicant should change "elastomer" to -- elastomeric -  
- in line 2.

### *Claim Rejections - 35 USC § 102*

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 2-10, 21-26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application 5-294104.

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This reference is applied for the same reasons as set forth in Paper Number 7 paragraph 6. Specifically, see paragraphs 0005-0021 of the translation. As to claims 8-10, 26, and 28, in the exemplary 1000D/2 polyester cord each strand of 1000 Denier has a cross-sectional area  $A = D/p = (\pi d^2/4) = 0.082 \text{ mm}^2$ , so the diameter  $d$  of each strand is about 0.32 mm which results in a cord diameter of about  $2 \times 0.32 \text{ mm} = 0.64 \text{ mm}$ ; the exemplary cord end count of 55 cords per 50 mm gives for each row an end count of 27.5 cords per 50 mm (0.55/mm) for a cord spacing in each row of  $1/0.55 = 1.8 \text{ mm}$ ; in the exemplary tire size of 185/60R14 the circumference of the flat carcass ply before expanding into the finished tire is about the same as circumference of the rim (14 inches = 356 mm), so the cord spacing in each row of 1.8 mm around a 356 mm circumference results in  $356 \text{ mm}/1.8 \text{ mm} = 198$  cords per row, well within the broadly claimed range of about 50 to about 600 cords per row. As to claim 7, the close structural correspondence (radial passenger tire with cord diameter, row spacing, and number of cords per row in the claimed ranges) between the carcass ply in the JP '104 tire and the claimed tire provide a reasonable basis for inferring that the JP '104 carcass ply would also meet the claimed broad carcass ply width of about 150 mm to about 250 mm, therefore burden shifts to applicant to show lack of inherency (see the case law in MPEP 2112 and 2112.01).

Applicant argues that the new method limitation of forming the body ply by extrusion requires a structural difference in the tire claims, however in the manufacturing embodiment of Figure 5 the rubber material still hot from the calender would flow around the cords of both layers, thus providing a reasonable basis for inferring that the body ply of this embodiment would be structurally indistinguishable from the claimed extruded body ply; burden therefore shifts to applicant to show lack of inherency (see the case law in MPEP 2112 and 2112.01). Further, the tire in claims 24-26 and 28 is not required to be a green (unvulcanized) tire; the heat of vulcanization would cause the rubber to flow around the cords of both layers of the body ply,

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thus providing a reasonable basis for inferring that the body ply of this embodiment would be structurally indistinguishable from the claimed extruded body ply; burden therefore shifts to applicant to show lack of inherency (see the case law in MPEP 2112 and 2112.01).

*Claim Rejections - 35 USC § 103*

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2-10, 21-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 5-294104 in view of Kiemer (4,274,821) and Ible (4,300,878).

JP '104 is discussed in paragraph 6 above. Extrusion is a notoriously well known technique for manufacturing cord reinforced plies for tires, as evidenced by Kiemer and Ible both cited by applicant for example; it would therefore have been obvious to one of ordinary skill in the art to use such a notoriously well known alternative technique to manufacture the body ply in the above tire.

9. Claims 8-10, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 5-294104.

This reference is applied for the same reasons as set forth in Paper Number 7 paragraph 8. Specifically, see paragraph 6 above: it would have been obvious to one of ordinary skill in the art to provide such conventional carcass cord count per row in the above tire. It should be noted that applicant did not challenge the examiner's position in the previous Office action that conventional carcass cord counts per row in such passenger radial tires would fall within the claimed range, therefore this is taken as admitted prior art as per MPEP 2144.03.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application 5-294104.

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This reference is applied for the same reasons as set forth in Paper Number 7 paragraph 9. Specifically, see paragraph 6 above: it would have been obvious to one of ordinary skill in the art to provide such conventional radial passenger tire carcass ply width in the above tire. It should be noted that applicant has not asserted any novelty for this feature in the original disclosure and that applicant did not challenge the examiner's position in the previous Office action that conventional carcass cord counts per row in such passenger radial tires would fall within the claimed range, therefore this is taken as admitted prior art as per MPEP 2144.03.

*Conclusion*

11. It appears from applicant's arguments that the crux of the invention lies in the method of manufacture of the tire rather than the tire itself, therefore applicant may wish to present the nonelected method claims 11-18 for examination in a divisional application.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059. The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703)308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9311 for regular communications and (703)872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Adrienne C. Johnstone  
Primary Examiner  
Art Unit 1733

Adrienne Johnstone  
May 19, 2003

